

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 17 and 18 are requested to be cancelled.

Claims 5, 8, 10, and 14-16 are currently being amended.

Claims 19-22 are being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-16, and 19-22 are now pending in this application.

In the November 15, 2005 Official Action, the Examiner objected to claims 5-6 and 14 due to the recitation of the phrase “can be,” which the Examiner asserted was passive and therefore “renders any recitation claimed after not be given patentable weight.” In response to this objection, Applicant has replaced the term “can be” with “is.”

The Examiner rejected claim 18 under 35 U.S.C. §112, first paragraph. As Applicant has canceled this claim without prejudice, Applicant submits that this rejection is now rendered moot.

The Examiner rejected claims 6, 7, 10, 15 and 16 under 35 U.S.C. §112, second paragraph, as being indefinite for various reasons. Each of these rejections is discussed in turn.

The Examiner has asserted that claim 6 recites the phrase “said providing” without sufficient antecedent basis. Applicant respectfully traverses this rejection. Claim 6 is dependent upon claim 2, which already describes “providing the at least one addressed

recipient with the media content...” Therefore, Applicant submits that there is no antecedent basis issue in claim 6 with regard to this phrase.

With regard to claim 7, the Examiner has taken the position that the phrase “a minimum amount of information necessary” is not defined by the claim and is indefinite. Applicant respectfully traverses this rejection and submits that one skilled in the art would easily understand the meaning of this phrase in light of the actual claim language and the specification. In particular, Applicant submits that “a minimum amount of information required” for a particular function is the smallest amount of information required for the task. One skilled in the art would clearly understand that such an amount is not defined in absolute terms, but instead depends upon the overall structure, as more information may be required in one system than another. The Examiner is encouraged to contact the Attorney for Applicant if he would like to discuss this term in greater detail.

The Examiner also rejected claims 10, 15 and 16 due to various antecedent basis-related issues. In response to these rejections, Applicant has amended the claims appropriately.

The Examiner provisionally rejected claims 1-18 under the judicially created doctrine of double patenting over claims 17, 40, 42 and 43 of copending application Serial No. 10/149,639 and that of claim 21 of copending application Serial No. 09/920,910. Applicant traverses this provisional rejection. First, Applicant notes that the only grounds that the Examiner has given for this rejection are that “[t]he subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.” However, this is not the standard by which nonstatutory double patenting rejections are to be made. Section 804(II)(B)(1) of the Manual of Patent Examining Procedure is clear that, for obviousness-type double patenting, “the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent.” The question is not whether subject matter would be covered by any patent granted on the copending applications.

In light of the above, Applicant submits that the Examiner's provisional double patenting rejection is improper. In this case, the Examiner has failed to allege any valid reason why a double patenting rejection is warranted, while also failing to allege grounds as to why the pending claims would not be nonobvious over the relevant copending applications.¹ Applicant respectfully submits that each of the pending claims is patentably distinct over the two identified applications and, absent clear and specific assertions by the Examiner, Applicant submits that this provisional rejection is overcome.

The Examiner rejected claims 1-18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,430,177, issued to Luzeski et al. Applicant respectfully traverses these rejections. In particular, Applicant submits that the Luzeski et al. reference fails to teach or disclose the use of a database comprising recipient data describing multimedia reception capabilities and/or reception preferences for at least one recipient. The Luzeski et al. reference describes the use of a fixed environment inbox that is accessible with different terminals. In this system, a user opens an inbox, upon which the contents of the inbox are shown and the user can download messages of interest. Although a server is used, the Luzeski et al. reference does not teach or even suggest how the server could account for preferences and capabilities of a recipient.

In the November 15, 2005 Official Action, the Examiner asserted that column 13, lines 18-33 and column 14, lines 6-12 for the proposition that the Luzeski et al. reference discloses a database which includes such capability and/or preference features. Applicant respectfully disagrees with this position. For example, column 13, lines 18-33 describes nothing more than how a client application uses downloaded messages or content messages. This section does not discuss or teach how the server's behavior can be modified to account to a recipient's preferences or capabilities. This feature is likewise absent from column 14, lines 6-12.

¹ Similarly, the Examiner has not asserted any reason for a double patenting rejection on the grounds that the claimed invention is not "independent and distinct" over the other copending applications pursuant to MPEP Section 804(II)(B)(2).

The present invention, on the other hand, provides a system where capabilities and preferences for individual recipients is taken into account. As is noted in page 13, lines 2-4 of the present application, “each addressed recipient may have different capabilities, and the streaming sessions may be established at different times and media content streamed in different formats.” The present invention, as identified in the pending independent claims, addresses this issue, for example with the database in Figure 1. In one embodiment, for example, the use of this database by a MMS relay allows the relay to take into account the configuration, capabilities, and subscription options of particular user agents (see, e.g., page 26, lines 10-13). The Luzeski et al. reference provides no such teaching.

Because the Luzeski et al. reference does not provide the teachings discussed above, Applicant respectfully submits that each of independent claims 1 and 11-13, as well as their respective dependent claims, are patentable over this piece of prior art.

Applicant would also like to note that it has amended claim 8 to clarify the nature of the claimed invention. In particular, claim 8 has been amended to more clearly describe how the network entity communicates with the at least one addressed recipient over a radio communications network. As the Luzeski et al. reference is directed to a fixed communication system, the use of a radio communication system also clearly defines over this reference.

In addition to the above, Applicant has added new claims 19-22. Each of these claims describe how the notification message and the outputting of notification messages are performed locally within a multimedia messaging service environment. This feature, as described at page 26, lines 23-25, allows the system to take into account “dynamic” factors such as the current traffic situation, load or availability of a MMS system or network resources when forming a streaming notification. Applicant submits that this feature is also neither taught nor disclosed in the Luzeski et al. reference.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1450. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1450. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1450.

Respectfully submitted,

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